

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN BLASS,
GARY GIBSON and MINDY L. AISEN

Appeal No. 95-3732
Application 08/172,110¹

ON BRIEF

Before WARREN, OWENS and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting appealed claims 1 and 3 through 7 and refusing to allow claim 9 which was added subsequent to the final rejection.² Claims 2 and 8 are also of record and have been objected to by the examiner apparently as being directed to allowable subject matter.³

¹ Application for patent filed December 23, 1993.

² See the specification (pages 14-15), the amendment of June 13, 1994 (Paper No. 4), and the amendment of November 8, 1992 (Paper No. 7).

³ See ¶ 2 of the advisory action of November 21, 1994 (Paper No. 8).

We have carefully considered the record before us,⁴ and based thereon, find that we cannot sustain the examiner's ground of rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, enablement, for the reason that "the specification is inadequate to support the assertion that any aminopyridine will treat any disease of the anterior horn cells" (answer, page 2; see also pages 3-4). It is well settled that under § 112, first paragraph, the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the assertions as to the scope of objective enablement set forth in the specification are in doubt, including reasons why the description of the invention in the specification would not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation, in order to establish a *prima facie* case under the enablement requirement of the first paragraph of § 112. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971).

We reverse this ground of rejection because the examiner has not sustained her burden of establishing a *prima facie* case under § 112, first paragraph, enablement. Even though the examiner has withdrawn the ground of rejection of the appealed claims under 35 U.S.C. § 101 on the basis that the "instant method is credible for the treatment of a disease of the anterior horn cells and thereby for increasing motor strength" (answer, page 2), she has advanced a contrary position with respect to § 112, first paragraph, enablement, in contending that it would be "unpredictable" to treat a human having a disease of the anterior horn cells with an aminopyridine in order to increase his/her motor strength because of the treatment of another disease of the anterior horn cells with an aminopyridine where the motor strength of the human was increased (answer, page 4). The examiner predicates her position on the theory that the nine aminopyridines encompassed by appealed claim 1 are not "pharmacologically equivalent," citing pharmacological differences between 3,4-diaminopyridine and 4-aminopyridine and the "questioned" "potential usefulness of 3,4-diaminopyridine in the treatment of multiple sclerosis" as set forth in Bever et al (answer, page 3), from which the examiner concludes that "each aminopyridine of the formula of claim 1 would not necessarily provide appropriate therapy for any disease of the

⁴ We refer to the examiner's answer and to appellants' principal and reply briefs for a complete

anterior horn cells where increasing motor strength is sought” (answer, page 4).⁵ Appellants dispute the examiner’s findings with respect to Bever et al in their brief (page 7) and reply brief (page 2), unchallenged by the examiner.

We find no basis in the statements in the Bever et al article relied on by the examiner, particularly in view of appellants’ arguments, which would lead one of ordinary skill in this art to reasonably conclude that the aminopyridine compounds discussed therein would *not* have *similar* pharmacological properties or utility. Thus, the examiner’s conclusions that the method of treatment specified in the appealed claims is “unpredictable” and “would not necessarily provide appropriate therapy” are indeed clearly speculative in nature as they are unsupported by the record as a whole. Accordingly, the record on this appeal is devoid of a reasonable explanation why the assertions as to the scope of objective enablement set forth in appellants’ specification are in doubt, including reasons why the description of the invention therein would not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation as required by § 112, first paragraph, enablement.

exposition of the respective positions advanced by the examiner and appellants.

⁵ The examiner’s conclusion appears to be at odds with her indication that claim 2 of record is objected to along with claim 8 of record, apparently because both claims are drawn to allowable subject matter

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

(*see supra* note 3), since the former claim depends on appealed claim 1 and thus reads on methods of treating any disease of the anterior horn cells with 3,4-diaminopyridine.

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